

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Jon Ocel et al.

Serial No.: 10/056,807

Filed: January 25, 2002

Docket No.: M190.134.101

Title: FLUID-ASSISTED ELECTROSURGICAL INSTRUMENT WITH SHAPEABLE ELECTRODE

REMARKS

This is responsive to the Final Office Action mailed May 12, 2004. In that Office Action, the Examiner rejected claims 1-4, 7-18, 24-31, and 33-43 under 35 U.S.C. §102(b) as being anticipated by Hovda et al., U.S. Patent No. 6,053,172 ("Hovda"). Claims 44-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schroepfel, U.S. Patent No. 6,395,038 ("Schroepfel"). Claims 1-11, 13-16, and 24-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hovda in view of Panescu et al., U.S. Patent No. 5,688,267 ("Panescu"). Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hovda in view of Moaddeb et al., U.S. Patent No. 6,405,078 ("Moaddeb"). Claims 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hovda in view of Knoepfler, U.S. Patent No. 5,300,087 ("Knoepfler"). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hovda in view of Knoepfler.

With this Response, claims 51 and 52 have been added. Claims 1-52 are pending in the application and presented for reconsideration and allowance.

35 U.S.C. §§102 and 103 Rejections

On page 2 of the Office Action, the Examiner rejected claims 1-4, 7-18, 24-31, and 33-34 under 35 U.S.C. §102(b) as being anticipated by Hovda. On page 6 of the Office Action, claims 1-11, 13-16, and 24-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hovda in view of Panescu. Also, throughout the Office Action, various dependent claims were rejected under 35 U.S.C. §103(a).

Independent claims 1 and 24 relate, in part, to an electrosurgical instrument, and include an elongated shaft adapted to be transitionable from, and independently maintain a shape in, a straight state and a first bent state. Independent claim 39, relates, in part, to a method of performing an electrosurgical procedure, and includes providing an electrosurgical instrument including an elongated shaft. The shaft is bent to a first bent state in which a portion of the shaft is deflected relative to a linear axis of the shaft, wherein the shaft independently maintains the

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shape of the first bent state. For at least the reasons below, the cited references do not expressly or inherently teach or suggest such limitations.

It is Applicant's believe that the Examiner is broadening the scope of Hovda through the inappropriate use of hindsight analysis and inherency. For example, on page 8 of the Office Action, the Examiner asserted that "the curves at elements 101 and 112 of shaft 100 shown in Hovda teach and/or suggest bending because a Nitinol (nickel/titanium alloy) shaft on an electrosurgical instrument would not be manufactured/prefabricated with curves because it would minimize the number of applications for which the instrument could be used." Also on page 8, the Examiner asserted that "one of the ubiquitous advantages of Nitinol shafts is their ability to be molded/bent into positions as governed by the specific application." and on page 9, the Examiner stated "Nitinol is a widely known type of nickel titanium alloy, especially known for the construction of electrosurgical device shafts."

It is Applicant's position that the Examiner is utilizing hindsight and inherency to broaden the scope of Hovda. In particular, there is no reference to nitinol in Hovda. The word "nitinol" is not used in Hovda. Rather, Hovda, in discussing materials to fabricate shaft 100 discloses "electrically conducting material, usually metal, which is selected from the group comprising tungsten, stainless steel alloys, platinum or its alloys, titanium or its alloys, molybdenum or its alloys, and nickel or its alloys." See Hovda, at column 17, lines 4-8. There is no discussion in Hovda regarding malleability or bending properties or processes when referencing the listed electrically conducting materials. Nor is there discussion regarding a shaft capable of independently maintaining distinct shapes when referencing the listed materials. Rather, these materials are listed because, in fact, they are examples of electrically conducting materials. The use of hindsight and/or inherency is necessary to transform the quoted language into a shaft capable of independently maintaining distinct shapes.

As further evidenced that Hovda does not disclose a shaft of an electrosurgical instrument capable of independently maintaining distinct shapes as claimed, Hovda discloses "a shaft having a 90° bend angle may be particularly useful for accessing tissue located in the back portion of the mouth and a shaft having a 10% to 30% bend angle may be useful for accessing tissue near or in the front portion of the mouth or nose." (Emphasis added.) See Hovda, at

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column 18, lines 3-7. Clearly, if Hovda had contemplated disclosure of a single electrosurgical instrument capable of being bent and re-bent into various distinct shapes, where the shaft independently maintains distinct shapes, two separate and distinct shafts would not be described and disclosed in the quoted language. Rather, a single shaft capable of maintaining two distinct shapes would have been discussed. The use of hindsight and/or inherency is necessary to transform the quoted language into a single shaft capable of independently maintaining distinct shapes.

According to M.P.E.P. §2112, quoting *ex-parte levy* 17 U.S.P.Q. 2d 1461 (Pd. Pat. App. and Inter. 1990), “in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support that determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Clearly, disclosing “titanium and its alloys” or “nickel and its alloys” with reference to electrically conducting materials fails to teach or suggest the limitations of claims 1, 24, and 29 as such limitations do not “necessarily flow” from the Hovda disclosure. The Examiner is moving from “titanium and its alloys” and “nickel and its alloys” to nitinol to “known” characteristics and features of nitinol without any discussion or inference of malleable or bendable characteristics of the listed metals. If the Examiner’s position were correct, merely disclosing a shaft made of “metal” would be sufficient to teach malleable metals. However, without more, such as teaching, suggesting, or disclosing the desirability of malleable metals, a bendable characteristic, or an analogous bending process, the enumerated limitations of claims 1, 24, and 39 do not necessarily flow from the materials disclosed in Hovda.

For at least the reasons outlined above, it is believed that independent claims 1, 24, and 39 present patentably distinct material from the cited references. In addition, as claims 2-23, 25-38, and 40-50 depend from claims 1, 24, or 39, they are believed to present patentably distinct matter for similar reasons. As such, the Examiner’s rejections of claims 1-50 is respectfully traversed and allowance of those claims is requested.

Newly added claims 51 and 52 depend from independent claim 39. It is believed that these claims are supported by the specification, for example, at page 18, lines 12-24, such that no new matter is added. It is believed that these claims present patentably distinct matter from the

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cited references. In particular, none of the listed references teach, suggest, or disclose a method of performing an electrosurgical procedure which includes evaluating a constraint presented at a tissue target site, wherein evaluating the constraint occurs after providing the electrosurgical instrument, but prior to bending the shaft. Similarly, a method of performing an electrosurgical procedure which includes determining an optical shape of the elongated shaft after evaluating the constraint presented at the tissue site, but prior to bending the shaft is not disclosed in the cited references. As such, allowance of these claims is respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-52 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-52 is respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 the amount of \$36.00 to cover the fees as set forth under 37 C.F.R. 1.16(b)(c).

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The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of November, 2004.

By Michael R. Binzak

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